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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,808	05/22/2001	Yijun Deng	ORT-1432	1171

27777 7590 10/01/2004  
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EXAMINER

ANDERSON, REBECCA L

ART UNIT PAPER NUMBER

1626

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/862,808	<b>Applicant(s)</b> DENG ET AL.	
	<b>Examiner</b> Rebecca L Anderson	<b>Art Unit</b> 1626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 July 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-3, 21 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

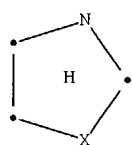
### DETAILED ACTION

Claims 1-3, 21 and 22 are currently pending in the instant application and are objected. Claims 4-20 and 23-30 were cancelled in the amendment filed 5 June 2003, claims 21 and 22 were amended in the amendment filed 6 January 2004 and claim 1 was amended in the amendment filed 12 July 2004.

### *Election/Restrictions*

The subject matter of claims 1-3, 21 and 22 other than that wherein:

**X** is selected from the group consisting of NH and NR<sup>A</sup> wherein R<sup>A</sup> is selected from the group consisting of hydrogen and -R, wherein -R is aralkyl;



represents a 5 membered aromatic ring structure **containing no additional**

**heteroatoms**, optionally substituted with one to three substituents independently selected from the group consisting of halogen, hydroxy, alkyl, halogenated alkyl, alkenyl, cycloalkyl, alkoxy, aryl, aralkyl, amino, mono-or di-substituted amino, cyano, nitro, -COOR, -COR, SO<sub>2</sub>R and CONR<sup>B</sup>R<sup>C</sup>, wherein the amine substituents are independently selected from alkyl, cycloalkyl, aryl or aralkyl, wherein the cycloalkyl or aryl may be further optionally substituted with one or more substituents selected from halogen, hydroxy, alkyl, halogenated alkyl, alkoxy, amino, mono-or di-substituted amino, cyano or nitro;

**Z** is OR<sup>A</sup> wherein R<sup>A</sup> is -CONR<sup>C</sup>R<sup>D</sup>;

**R<sup>3</sup>** is selected from the group consisting of hydrogen, alkyl, aralkyl, cycloalkyl, and fluorinated alkyl, wherein the aralkyl may be optionally substituted with one or more

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substituents independently selected from halogen, hydroxy, alkyl, halogenated alkyl, alkoxy, amino, mono-or di-substituted amino, cyano or nitro;

$R^4$  is selected from the group consisting of alkyl, aryl, aralkyl, cycloalkyl, fluorinated alkyl, alkenyl and alkynyl, wherein the alkyl, alkenyl, alkynyl, aryl or aralkyl may be optionally substituted with one or more substituents independently selected from halogen, hydroxy, alkyl, halogenated alkyl, alkoxy, aryl, amino, mono-or di-substituted amino, cyano or nitro;

$R$  is selected from the group consisting of alkyl, aryl, aralkyl, cycloalkyl and fluorinated alkyl, wherein the aryl or aralkyl may be optionally substituted with one or more substituents independently selected from halogen, hydroxy, alkyl, halogenated alkyl, alkoxy, amino, mono-or di-substituted amino, cyano or nitro;

$R^B$  is independently selected from the group consisting of hydrogen,  $-R$ ,  $COOR$ ,  $-COR$ ,  $SO_2R$ ,  $SOR$  and  $-CONR^C R^D$ ; and

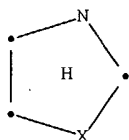
$R^C$  and  $R^D$  are independently selected from the group consisting of hydrogen, alkyl, aryl, aralkyl, cycloalkyl and fluorinated alkyl, wherein the aryl or aralkyl may be optionally substituted with one or more substituents independently selected from halogen, hydroxy, alkyl, halogenated alkyl, alkoxy, amino, mono-or di-substituted amino, cyano or nitro,

are withdrawn from consideration as being for non-elected subject matter.

The remaining subject matter of claims 1-3, 21 and 22 that is not drawn to the above elected invention stands withdrawn under 37 CFR 1.142(b), as being for non-elected subject matter, for reasons essentially those given in the previous office

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actions. The remaining compounds which are not within the elected invention, which are independent and distinct from the elected invention and do not have unity with the species elected and therefore are withdrawn by means of a restriction requirement within the



represents a 5 membered aromatic ring structure that can

containing additional heteroatoms;

and

The 5-membered ring is substituted with one to three substituents selected from heterocyclyl.

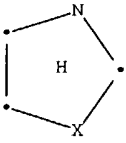
The above mentioned withdrawn compounds which are withdrawn from consideration as being for non-elected subject matter differ materially in structure and composition from the compounds of the elected invention. The withdrawn compounds contain varying functional groups which differ from those of the elected invention such as indolyl, imidazolyl, thiazolyl, furyl, etc. which are chemically recognized to differ in structure and function. This recognized chemical diversity of the functional groups can be seen by the various classification of these functional groups in the U.S. classification system, i.e. class 548 subclasses 577(+) (indolyl), class 548 subclasses 300.1(+) (imidazolyl), class 548 subclasses 146(+) (thiazolyl), class 549 subclasses 429 (+) (furyl), etc. Therefore, again, the compounds which are withdrawn from consideration as being for non elected subject matter differ materially in structure and composition and have been restricted properly as a reference which anticipated but the elected

subject matter would not even render obvious the non-elected subject matter. Nowhere do applicants argue to the contrary. Nowhere do applicants point out and give reasons why the claims do not involve independent or distinct subject matter.

These withdrawn compounds are independent and distinct from the elected invention and do not have unity with the species elected and are therefore withdrawn by means of a restriction requirement within the claims. The above elected invention does not improperly limit the scope of applicants claims because applicant's claims involve more than one independent or distinct invention. Under 35 U.S.C. 121, the claims may be restricted and the examination limited to a restricted invention. Accordingly, restriction as has been presented in this application is proper, repeated and the finality is maintained.

### ***Response to Amendment***

Applicant's amendment filed 12 July 2004 has been entered and claim 1 was amended. Applicant's arguments filed 12 July 2004 have been fully considered but they are not persuasive. Applicant argues that the pending claims have been amended in accordance with the elected invention identified on pages 2-4 of the office action mailed 5 April 2004 indicated to be allowable. However, this argument is not found persuasive since the claims still include non-elected subject matter, such as, for example, wherein the 5 membered aromatic ring structure is optionally substituted with heterocyclyl and

optionally substituted heterocyclyl, and wherein  represents a 5 membered aromatic ring structure that can containing additional heteroatoms.

### ***Objections***

Claims 1-3 are objected to as containing non-elected subject matter. Claims 1-3 presented drawn solely to the elected invention as identified supra would appear allowable over the prior art of record.

Claims 21 and 22 are objected to as being dependent on an objected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday 5:30AM to 2:00PM.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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